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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,242	07/29/2003	Takao Suzuki	Q71333	4750

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EXAMINER	
SHEEHAN, JOHN P	
ART UNIT	**PAPER NUMBER**
1742	

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/628,242	SUZUKI ET AL.	
	Examiner	Art Unit	
	John P. Sheehan	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Interpretation

1. Applicants are advised the Examiner has interpreted the phrase, "3d transition metal elements" used throughout the claims, to be limited to the elements Cr, Mn, Fe, Co, Ni and Cu as set forth in the specification in paragraph [20].

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mizumoto et al. (Mizumoto, EPO Document No. 0 364 631 A1).

Mizumoto teaches a specific example alloy, $Pt_{46}Ni_1Co_{53}$, that is encompassed by applicants' claim 1 (page 9, Table 1, Example 3). This example alloy anticipates applicants' claim 1.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mizumoto et al. (Mizumoto, EPO Document No. 0 364 631 A1).

Mizumoto teaches a specific example alloy, $Pt_{46}Ni_1Co_{53,}$ that is encompassed by applicants' claim 1 (page 9, Table 1, Example 3).

Mizumoto and claims 2 and 3 differ in that Mizumoto is silent with respect to the properties recited in applicants' claims 2 and 3.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy taught by Mizumoto has a composition that is encompassed by the instant claims. In view of this, the alloy taught by Mizumoto would be expected to posses all the same properties as recited in instant claims 2 and 3, In re Best, 195 USPQ, 430 and MPEP 2112.01.

> "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada,15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not

necessarily possess the characteristics of the claimed product. In re Best,195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

Claim Rejections - 35 USC § 103

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizumoto et al. (Mizumoto, EPO Document No. 0 364 631 A1).

Mizumoto teaches as set for above. Mizumoto teaches that the disclosed alloy is used as a magnetic memory medium (page 8, lines 46 to 49).

The use Mizumoto's disclosed alloy for its disclosed utility as recited in claims 4 and 5 is obvious.

Response to Arguments

7. Applicant's arguments filed December 2, 2005 have been fully considered but they are not persuasive.

Applicants' argue that the instant claims recite an average number of valence electrons in the respective 3d transition metal elements of from 7 to 9 whereas for the specific example alloy, $Pt_{46}Ni_1Co_{53}$, taught by Mizumoto it is 9.02. The Examiner is not persuaded. The claimed upper limit of 9 for the average number of valence electrons in the respective 3d transition metal elements and 9.02 for the specific example alloy taught by Mizumoto are very similar and closely approximate each other, therefore one of ordinary skill in the art would have expected Mizumoto's example alloy and the instantly claimed to have the same properties. The instant situation is analogous to that

set forth in *In re Peterson,* 65 USPQ2d 1379, 1382, citing *Titanium Metals Corp. v. Banner*, 227 USPQ 773, 779 and MPEP 2144.05.

> "a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties.*Titanium Metals Corp.of America v.Banner* ,778 F.2d 775, 227 USPQ 773 (Fed.Cir.1985)

8. Applicants' argue that the intended uses of the instantly claimed alloy and Mizumoto's alloys are different and therefore the characteristics necessary to the present invention are totally different from those of Mizumoto's magneto-optical recording media. The Examiner is not persuaded. The disclosure of a different intended use does not lend patentability to a claimed invention. Further, applicants have not provided any evidence in support of their assertion. Arguments unsupported by evidence are entitled to little, if any, weight, In re Payne USPQ 245, 256 (CCPA1979; In re Lindner 173 USPQ 356, 358 (CCPA 1972).

9. Applicants argue that Mizumoto's alloy is amorphous whereas the present invention relates to a crystallized structure. The Examiner is not persuaded. Applicants' claims are silent with respect to the crystalline structure of the claimed alloy and therefore encompass the amorphous structure taught by Mizumoto.

10. Applicants' arguments regarding the "S" value recited in claims 2 and 3 are not persuasive. Applicants have not provided any evidence to support their assertion that the "S" value of Mizumoto's alloy is zero.

Conclusion

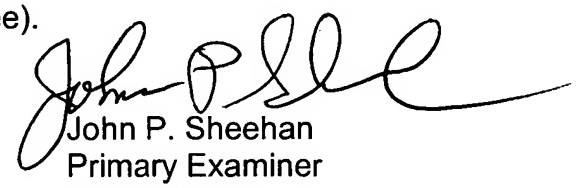
11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Sheehan
Primary Examiner
Art Unit 1742

jps